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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/245,493	02/05/1999	DAVID CINCOTTA	2435.1	4947

5514 7590 04/30/2003

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EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/245,493

Applicant(s)  
Cincotta

Examiner  
Nga B. Nguyen

Art Unit  
3628



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 23, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 24 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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### **DETAILED ACTION**

1. This Office Action is the answer to the Amendment filed on July 23, 2001, which paper has been placed of record in the file.
2. Claims 1-5 and 24 are pending in this application.

#### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-5 and 24 have been considered but are moot in view of the new ground of the rejection.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al, U.S. Patent No. 5,794,207.

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Regarding claim 5, Walker discloses a financial data processing system for allowing a plurality of participants to prepay for services or goods to be received at a later date from one of a plurality of specified providers, comprising:

a machine-readable storage device which stores data indicating measures of services or goods for which each participant has prepaid and measures of services or goods which each provider has contracted to provide (column 12, line 54-column 13, line 67);

a processing circuit for determining, for each of the providers, a predicted total measure of services or goods that will be required from that provider by the aggregate of the plurality of participants (column 12, lines 3-53 and column 18, line-column 19, line 28).

wherein the system is configured such that cash amounts that correspond to measures of services or goods are set by each provider and such that the participants select which of the plurality of providers will deliver the services or goods at the time the services or goods are to be provided (column 22, line 40-column 23, line 18).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-4 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wladis, John D. (hereinafter Wladis), "U.C.C. section 2-207: the drafting history", Business Lawyer.

Regarding claim 1, Wladis discloses a method, to be administered by an administering entity, for allowing a plurality of participants to prepay for services or goods to be received at a later date from one of a plurality of specified providers, the method comprising the steps of:

executing contracts between the administering entity and each of the plurality of participants (see bold on page 5, buyer places a contract with seller);

executing contracts between the administering entity and each of the plurality of specified providers (see bold on page 5, seller places a contract with manufacturer).

Wladis does not specifically teach a contracting participant pays to the administering entity a cash amount and in return receives from the administering entity a promise to deliver at a future date a specified measure of services or goods, the services or goods to be provided by whichever of the plurality of specified providers the contracting participant selects; determining, for each of the plurality of specified providers, a predicted total measure of services or goods that will be required from that provider by the aggregate of the plurality of participants; the administering entity pays to a contracting provider a cash amount and in return receives from the contracting provider a promise to deliver a specified measure of services or goods, the cash amounts that correspond to the measures of services or goods being set by the provider.

However, claim 1 appears to read on ordering a product through a middle man, authorized dealer,

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seller or retailer who then must order the product from a wholesaler or the manufacturer. For example, it is well known that a retailer offers for sale a variety of products not all of which are in stock or some of the products are “custom made”, “made to order” or “special order only”. The customer typically selects a product from a particular manufacturer at the retailer then puts a deposit down or even pays in full to place an order with the retailer, then the retailer will deliver the product to the customer. This order is effectively a sales “contract” with the retailer. The retailer then must order the out-of-stock or special order product from a wholesaler or the manufacturer. The retailer puts a deposit down or even pays in full to place an order with the manufacturer, then the manufacturer will deliver the product to the retailer. Thus the retailer enters into another sales contract with the wholesaler or manufacturer to supply the product. It is well known that wholesalers or manufacturers set the price for their products that the retailer would pay. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the features discussed above with Wladis’s for the purpose of executing the sale contract between the customer and the retailer and between the retailer and the manufacturer.

Regarding claim 2, Wladis does not disclose the administrating entity ascertains the measure of services or goods to be specified in each contract with a provider in accordance with the predicted total measure of services or goods that will be required from that provider. However, it is well known that when the retailer places contract orders with the manufacturer, the retailer ascertains the products in each contract, and the manufacturer sets the price for their

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products that the retailer would pay. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the features discussed above with Wladis's for the purpose of executing the sale contract between the retailer and the manufacturer.

Claims 3, 4 are written in means and have the same limitations found in claims 1, 2 discussed above, therefore, are rejected by the same rationale.

Claims 24 is written in computer software and have the same limitations found in claim 1 discussed above, therefore, is rejected by the same rationale.

### ***Conclusion***

8. Claims **1-5** and **24** are rejected.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Souh, can be reached on (703)308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1113.

10. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 3600

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Washington, D.C. 20231

**or faxed to:**

(703) 305-7687, (for formal communications intended for entry)

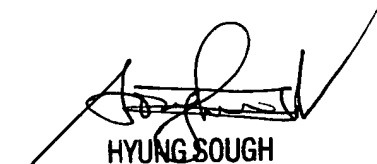
**or:**

(703) 308-3961 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen  
March 31, 2003



HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600